

REMARKS

Please reconsider the claims in the application in view of the remarks below. In the present application, claims 1-14 remain pending. The Office Action rejected claims 1, 6, and 12 on the grounds of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-3, 9, 12, and 21 of U.S. Patent No. 6,745,208. Applicant will file a terminal disclaimer if needed when all other rejections are resolved. The filing of the terminal disclaimer to obviate the rejection is not an admission of the propriety of the rejection.

The Office Action also rejected claims 11-14 under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. In order to advance the prosecution, applicant is amending claim 11 to recite "a program embodied in a storage medium." Such amendment, however, is not an admission on the part of the applicant that the rejection is proper. Rather, it is believed that the originally recited "program for controlling a computer" claims are also patentable at least because they are directed to the practical utility of editing an application having a model and view separated from each other. For instance, see the Federal Circuit's decisions in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368 (Fed. Cir. 1998), a case involving a data processing system for administering mutual funds, *AT&T Corp. v. Excel Communications Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), a case involving a method for billing long-distance telephone customers, and the recent PTO's Board of Patent Appeals and Interferences decision in *Ex parte Lundgren*, Appeal No. 2003-2088, in which the board held that a claimed method for compensating a manager could be eligible for patent protection even though the claims do not disclose a computer or apparatus of any kind. In those cases, the Federal Circuit and the PTO's Board alike focus on the practical utility aspect of the

claims regardless of a computer or apparatus in determining eligibility under section 101. In the present application, claims 11-14 recite the practical application of “controlling a computer to edit an application having a model and view separated from each other.” Therefore, applicant believes that original claims 11-14 also recited a statutory subject matter.

Claims 1-14 were further rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Applicant’s admitted prior art (“APA”) in view of U.S. Patent No. 6,792,431 to Tamboli et al. (“Tamboli”). Applicant respectfully traverses the rejection.

As understood by applicant, Tamboli discloses a method of creating a system implementing a dynamic common model for integrating data. The subject matter with which Tamboli is concerned is database repositories. Unrelated to Tamboli, the background section of the present application on pages 1 and 2 describes displaying and changing different views of an application model in which those different views are adapted to an interface supporting the model. That section then continues on page 2 to give examples of and to characterize the inefficiencies in some of the possible techniques for displaying different views of an application model when there are no interfaces for providing the desired view for that particular application.

The claims in the present application recite methods in several embodiments that overcome the shortcomings of those existing possible techniques discussed in the background section of the present application, that is, those techniques that display different views when there are no interfaces for providing the desired view for that particular application. The claims in the present application are directed to displaying and updating a view to an application model where there is no interface for displaying the application model in that particular view. As such APA does not disclose or suggest the elements of claims 1-14 as alleged in the Office Action. For instance, while not completely clear, it appears that the Office Action is alleging that APA

discloses every element claimed except for an event generator, which the Office alleges that Tamboli discloses.

Contrarily, however, APA, taken alone or in combination with Tamboli, does not disclose, suggest, or teach every element claimed in claims 1-14. For instance, APA on pages 1 and 2 does not disclose, suggest, or teach at least “a view of said second model ... wherein said view display module ... changes the view ... if said second model is updated based on an edit of said first model ...”. The Office Action cites pages 1-2 of the present application as allegedly disclosing that element. However, as described above, those pages describe displaying and changing different views to the same model where the model includes an interface adapted for displaying the different views. Claim 1 on the other hand claims changing the view of a second model as a result of an edit to a first model. Therefore, for at least this reason, applicant believes that the Office Action’s assertion that APA discloses every element claimed except for an event generator is erroneous.

In addition, Tamboli does not disclose or suggest an event generator. The Office Action cites Tamboli’s Col. 4, lines 15-26, as allegedly disclosing that element. That passage of Tamboli recites: “The dynamic common model itself comprises elements useful for automatically upgrading the dynamic common model to include changes in source repository structures. In fact, changes typically are administered in a similar manner as additions of new repositories. “Automatic upgrading” in this sense means that upon activation, a new adapter automatically registers itself and its new repository with a data integration application to which it is coupled for data communications and a spider then automatically enters in a catalog identifying information for all the records in the new repository served by the new adapter.” That section as recited in verbatim hereinabove does not disclose or suggest generating an event.

Rather, these passages simply teach that the dynamic common model is updated when changes are made to a source repository. When a new repository is added, the associated adapter registers itself and the new repository with a coupled data integration application. Thereafter, a spider enters identifying information into a catalog. The adapter registration and spider entering identifying information are not based on an edit made to a source repository. Tamboli does not generate and event, for instance, in response to changes being made to a source repository or otherwise. Accordingly, applicant believes that Tamboli does not disclose, suggest, or teach "an event generator for generating an event based on an update in said second model if said second model is updated based on an edit of said first model made by said editing module." Consequently, the Office Action's reliance on Tamboli is misplaced.

While applicant believes that the above reasons suffice to overcome the rejections over APA and Tamboli, applicant further proffers the following reasons why the Office Action's obviousness rejections must fail. To establish a prima facie case of obviousness, first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The Office Action fails to establish a prima facie case of obviousness at least because neither APA nor Tamboli provides the necessary suggestion or motivation to combine the references. Tamboli as discussed above is directed to data integration of database models or repositories. Tamboli is not at all concerned with editing an application having a model and a view separated from each other. Tamboli nowhere even hints on displaying different view formats of an application. Rather, Tamboli appears to be concerned with database standards as its passage in Cols. 2-4 seems to indicate. Similarly, APA provides no suggestion

or motivation to combine the teachings of Tamboli to arrive at the claims claimed in the present application. Accordingly, it is believed that combining APA and Tamboli is improper.

In view of the foregoing, applicant respectfully submits that APA and Tamboli, whether taken alone in combination, do not teach or suggest the subject matter recited in Applicant's independent claim 1. Independent claims 6, 11, and 12 recite features similar to those recited in claim 1, and therefore are not obvious over APA and Tamboli for at least the reasons discussed in connection with independent claim 1. With respect to claim 6, applicant further proffers an additional reason as to why claim 6 is not obvious over APA and Tamboli. Claim 6 recites in part, "converting an event ... into an event ...". Neither APA nor Tamboli discloses, suggests or teaches converting events. Therefore, applicant believes claim 6 is further distinguishable for at least this additional reason.

Claims 2-5, 7-10, and 13-14, which depend directly from the independent claims 1, 6, and 12, incorporate all of the limitations the corresponding independent claim and also are not obvious over APA and Tamboli for at least those reasons provided for claims 1, 6, and 12.

In view of the foregoing, this application is now believed to be in condition for allowance, and a Notice of Allowance is respectfully requested. If the Examiner believes a telephone conference might expedite prosecution of this case, applicant respectfully requests that the Examiner call applicant's attorney at (516) 742-4343.

Respectfully submitted,



Steven Fischman
Registration No.: 34, 594

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, N.Y. 11530
(516) 742-4343